

20 45. (Amended) The method of claim 38 or claim 42, wherein expelling warmed air through the surface includes expelling the warmed air through an array of apertures in the surface

C6 [further comprising deploying a drape formed at the periphery of the inflatable device to trap warmed air under the surface].

REMARKS

The drawings, specification and claims have been amended. Claims 26-45 remain in the application.

The Specification has been amended at Page 1 to identify copending applications that share a common ancestor application with this one.

The summary and abstract have been amended to limit them to the claimed subject matter.

Claims 27-30, 33-36, and 45 have been amended in order to ensure that they uniformly recite subject matter entitled to the filing date of the first filed ancestor continuation-in-part application, which is 2 August 1988. Claim 42 has been amended to more clearly and precisely recite the invention.

Objection has been made to the drawings and specification. Figure 7 in the specification has been amended in order to rectify the informalities pointed out by the Examiner. Accordingly, the bases for these objections have been removed and the applicant respectfully requests that they be withdrawn.

A recent CAFC decision Augustine Medical, Inc. v. Gaymar Industries, Inc., 50 USPQ2d 1900 (CAFC 1999) concerns patents related to the present application and has been included with the Information Disclosure Statement submitted with this response. In this decision, the CAFC limits the inflatable thermal blankets claimed in those patents to thermal blankets which are self-erecting. The applicant in the present application has specified in the claims "an inflatable cover" (claims 26-37) and "an inflatable device" (claims 38-45). Such terms are expressly intended to be broader than the terms used in the claims addressed by the CAFC decision and to ensure that the covers and devices claimed in the present application are not limited to self erecting inflatable thermal blankets.

Claims 26-45 have been rejected for obviousness-type double patenting over U.S. Patent Nos. 5,184,612; 5,300,102; and 5,324,320. An accompanying Terminal Disclaimer has removed the bases for these rejections and the applicant respectfully requests that they be withdrawn.

Claims 26, 29, 32, and 37 have been rejected for anticipation by U.S. Patent No. 5,472,188 ("Augustine '188"). That rejection is respectfully traversed as follows.

Axiomatically, rejection of a claim for anticipation by a reference requires that the reference contain, within its four corners, all of the elements and limitations, and the relations therebetween, that are recited in the rejected claim.

Claim 26 recites a system including a heater/blower assembly to inflate an inflatable cover with warmed air. The inflatable cover has an undersurface for expelling warmed air from the inflatable cover. The heater/blower assembly maintains "the temperature of warmed air expelled through undersurface in the range 85° F to 117° F." In other words, the system recited in this claim maintains the temperature of warmed air that is "expelled through the undersurface" of an inflatable cover in a temperature range. In Claim 32, a similar system has a heater/blower assembly that provides warmed air to inflate the inflatable cover. The heater/blower assembly maintains "the temperature of the warmed air" that inflates the inflatable cover in another temperature range. Thus, in Claim 26, the warmed air expelled through an undersurface is in a temperature range that is different than the temperature range of warmed air provided to inflate the inflatable cover in Claim 32.

In Augustine '188 at C. 3, ll. 59-62, a heater/blower assembly "causes air heated to a predetermined temperature to be blown through the delivery hose 38 and the nozzle 36 into the keystone tube 15 of the cover 14." The passage goes on to say at C. 3, ll. 62, *et seq.* that the "temperature-controlled air circulates from the keystone tube 15 through the transverse ports 30 into all of the other tubes which form the cover 14". The passage thus describes the path by which the air introduced into the cover 14 fully inflates the tubes of the cover and exits exit ports. Neither this passage nor any other passage in Augustine '188 describes a heater/blower assembly that maintains the temperature of warmed air expelled through the undersurface of an inflatable cover at any particular temperature or in any temperature range whatsoever. Neither does the passage describe a heater/blower assembly that provides warmed air to inflate an inflatable cover with warmed air whose temperature is maintained in a range. Augustine '188 merely mentions a "predetermined"

temperature "to be blown through the delivery hose 38". Where this air is measured is not set forth, nor is there description of any range within which the temperature of this air is maintained. As admitted in the second full paragraph on page 5 of the Office Action:

" . . . Augustine et al. does not explicitly state the temperature range for air in the inflatable blanket . . .".

Although explicit range values are recited in Claims 26 and 32, these values are not necessary to patentably distinguish these claims, and other claims of the application, from Augustine '188. Variations in the many factors of thermal treatment of patients by inflatable devices would shift the ranges somewhat from one configuration to another. However, the central fact is that, to deliver effective thermal treatment of patients in a variety of (often dynamic) circumstances and to a variety of patients, ranges of values are necessary in order to maintain an optimum operation for any particular case.

If the locations and descriptions of temperature ranges that are set forth in Claims 26, 29, 32 and 37 are considered to be inherent in Augustine '188, the applicant requests introduction of extrinsic evidence establishing that the reasonably skilled artisan would appreciate that the omitted subject matter is necessarily present in this reference. Otherwise, the applicant respectfully requests withdrawal of this rejection.

Claims 38-44 have been rejected for obviousness over Augustine '188. That rejection is respectfully traversed as follows.

Axiomatically, rejection of a claim for obviousness over a reference requires, *prima facie*, a suggestion to modify the reference, a reasonable expectation of success, and, when the reference is modified, a teaching or suggestion of all claim limitations. The teaching or suggestion to modify the reference and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure.

Taking Claim 38 as exemplary, the invention is a method that includes deploying an inflatable device, inflating the device "with air warmed to a temperature in the range of 113° F to 121° F" and then expelling warmed air through a surface of the device. As the Office Action admits, Augustine '188 "does not explicitly state the temperature range for air in the inflatable blanket, . . .". In fact, Augustine '188 does not explicitly state that air in, introduced into, or expelled from an inflatable blanket has any "temperature range" whatsoever. It is proposed in the Office Action that

"it would have been obvious to one of ordinary skill in the art at the time of the invention to choose a predetermined temperature range to achieve the best heating results." Office Action, P. 5, second full paragraph.

The Augustine '188 patent is concerned with the structure of an airflow cover in which parallel elongate plastic tubes are joined to form an inflatable casing. One tube is joined to an adjacent tube by a seam through which transverse ports open between the adjacent tubes in order to support the circulation of an inflating medium. A heater/blower assembly 40 is connected to an input port 34 by way of delivery hose. The assembly causes air heated to a "predetermined temperature" to be blown through the delivery hose into the cover. The heated air flows into the tubes, causes them to inflate, and is forced out of exit ports in the tubes. No consideration in this passage or any other passage of Augustine '188 is given to any point at which temperature is measured in this assembly of elements. Nor is there any description or suggestion of the actual temperature magnitude in operating the air cover of the Augustine '188 patent. The "predetermined temperature" mentioned at C. 3, ll. 60 of Augustine '188 is not fertilized with a suggestion or further explanation of warming air "to a temperature" in any "range" of temperatures and inflating the air cover with air in any such temperature *range*. Indeed, the suggestion is that a single predetermined temperature value is all that is necessary to make the device operate correctly. It is noted that no value of the "predetermined temperature" is specified. The value could therefore be any one of an infinite set of temperature values not constrained in any range whatsoever. Furthermore, there is no suggestion in Augustine '188 for its modification to further specify or define "a predetermined temperature" so that it would be understood as "a temperature in the range" specified in Claim 38 or any equivalent range.

With respect to Claim 42, there is no suggestion to modify Augustine '188 for the purpose of "expelling warmed air" from an air cover at any temperature or in any temperature range. The specification merely sets forth that air of a predetermined temperature is blown into an air hose for inflating and circulating through an air cover. The laws of thermodynamics suggest that this temperature will be different from the temperature of air expelled through the air cover, however the reference does not. The reference makes no mention of any thermal relationship that achieves a predetermined temperature of air expelled from the described air cover, let alone a temperature in a "range" of any kind. In failing to suggest a modification of the reference for a temperature range,

the prior art also fails to suggest a temperature expelled that is in a range different from a temperature range of air used to inflate the air cover.

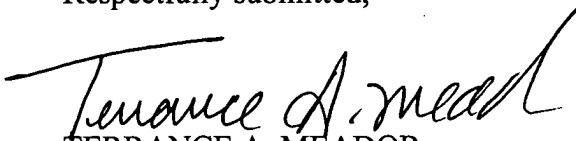
Accordingly, there is no suggestion to modify the Augustine '188 reference by air "warmed to a temperature" in a range, much less by air warmed to a temperature in any specific range for any purpose whatsoever. If it is considered that such a suggestion would occur "to one of ordinary skilled in the art at the time of the invention" the applicant respectfully requests introduction of evidence that clearly and particularly shows a suggestion to modify Augustine '188 as well as a suggestion that the modified reference include the step of inflating an inflatable device with air warmed to a temperature in any range whatsoever. The applicant respectfully points out that use of the inventors' disclosure as a blueprint for modifying Augustine '188 is not permitted under, among other decisions, *In re Dembiczak*, 50 USPQ2d 1614 (CAFC 1999).

The rejection for obviousness does not include any statement that modification of the Augustine '188 apparatus by temperatures at locations in specified ranges would result in successful operation of the device for any purpose. Indeed, the suggestion in the reference is that some single, unidentified "predetermined temperature" is all that is needed to make the airflow cover inflate and expel warmed air. In contrast, the rejected claims recite temperatures within temperature ranges, giving the claimed methods the flexibility to accommodate a great variety of conditions, elements, factors, and individuals.

Therefore, the rejection for obviousness falls short of the *prima facie* test for obviousness in each of the three measures. The applicant therefore requests withdrawal of this rejection.

Accordingly, all of the claims in the application recite subject matter that is patentably distinguishable from the references of record, early notice of which is requested.

Respectfully submitted,


TERRANCE A. MEADOR
Reg. No. 30,298

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GRAY CARY WARE & FREIDENRICH
401 B Street, Suite 1700
San Diego, California 92101

Telephone: (619) 699-2652 Fax: (619) 699-3452